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| 10/673,151  | 09/30/2003  | Kurt A. Dobbins             | 026215-00005        | 9799             |
| 4372 7590 07/21/2008<br>ARENT FOX LLP<br>1050 CONNECTICUT AVENUE, N.W.<br>SUITE 400<br>WASHINGTON, DC 20036 |             |                             |                     |                  |
| EXAMINER<br>JOHNS, CHRISTOPHER C  |             |                             |                     |                  |
| ART UNIT<br>3621  |             | PAPER NUMBER                |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/673,151

**Applicant(s)**

DOBBINS, KURT A.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)
- Paper No(s)/Mail Date 24 April 2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 2-15 are pending.
2. Examiner notes that Applicant did not challenge the Examiner's citations of Official Notice in the previous Office Action. Therefore, the cited limitations in claims 4, 5, and 8-15 are taken to be admitted prior art due to the failure to challenge the Examiner's assertions. See MPEP §2144.03 (C).

### ***Continued Examination Under 37 C.F.R. §1.114***

3. A request for continued examination under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 24 April 2008 has been entered.

### ***Claim Objections***

4. Claims 2-15 are objected to for usage of the functional language "configured to" throughout the claims. It is believed that Applicants intend "configured to" to mean "programmed to" since "configured to" is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing "configured to" to "programmed to" where a positive recitation is desired.

***Specification***

5. The amendment filed 24 April 2008 is objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. 35 U.S.C. §132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "distributed peer-to-peer network", as described in the arguments on pages 8 and 9 (especially the differences between the present invention and systems such as Napster, etc).
6. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112 1st Paragraph***

7. Claims 2-15 rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The idea of a "distributed peer-to-peer network" (which Applicant attempts to differentiate from the prior art of typical peer-to-peer networks) does not appear to be present in the originally-filed application.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 2 is rejected under 35 U.S.C. §102(b) as being anticipated by Transmission Films ("Films"), as described by "Netco test pay pic swap" (article from Daily Variety, 12 August 2002, hereafter "Netco"), and "Transmission Films revs up legal P2P site" (article from Video Business, 29 August 2003, hereafter "Video").

10. As per claim 2, Films discloses:

- a. data receiver configured to receive a first part of a content file transmission (inherent in the operation of any network protocol), and an indication of payment parameters (Netco, ¶3 – "Fees, which will be charged when a viewer goes to actually watch a downloaded film...") required for exploiting content of the content file transmission in a distributed peer-to-peer network (Netco, ¶1 – "a for-pay system...over a Napster-like network");
- b. payment logic for determining the payment parameters of the content file transmission in the distributed peer-to-peer network according to the indication of payment parameters, wherein the payment logic offers the option of billing payment to a network access provider of a subscriber, data transmitter to transmit a payment authorization request to a payment receiver (Netco, ¶3 – "Fees, which will be charged when a viewer goes to actually watch a downloaded film...");
- c. service logic for grouping first part of content file transmission and subsequent parts of the content file transmission as a communications flow in the distributed peer-to-peer network, switching apparatus for transporting the first part and subsequent parts of the content file transmission to a communications port according to the communications

flow determined by the service logic in the distributed peer-to-peer network (the portions of the file are inherently grouped together in a flow in the protocol used in Films (eDonkey2000, see enclosed reference “Documentation – Overview”) – the system decides where to acquire each portion of the file from, and acquires each portion from a different source. The resulting data transfer is a flow of information that forms a group of sources).

*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-7 and 12-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Films in view of Kids On-Line, by Salzman et al (“KOL”).

13. As per claims 3-7 and 12-15, Films in view of KOL teaches:

d. a preferred transporter for transmitting the content file transmission, wherein the preferred transporter recognizes the transmission of a content file transmission and transmits an offer to bill a network access provider to the subscriber (Films may not explicitly disclose billing network access to the subscriber. KOL discloses that this is how online services such as CompuServe, America Online, and Prodigy have worked - see KOL, page 17 (“CompuServe features ‘premium services’ such as research databases that are billed *in addition* to hourly connect-time rates” (emphasis original), page 19

("also charges additional fees for some 'extended' and 'premium' services..."), page 137 ("Homework Helper...two hours of use for \$9.95 a month"), and page 169 (footnote: "surcharge of \$2.50...").). These on-line services were well-known to those skilled in the art at the time of the invention as they created the cornerstone of today's Internet, including establishing billing through network access provider accounts. It would have been obvious to a person having ordinary skill in the art to include in Films the network billing ideas as taught by the services in KOL, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable);

e. authentication feature at the preferred transporter for automatically authenticating a subscriber at the preferred transporter by using a machine address of the subscriber's modem and binding it to a particular instance of at least one selected from a group consisting of a dynamic IP address and an authenticated subscriber identifier, wherein the authentication feature is configured to automatically authenticate a subscriber at the preferred transporter by using a machine address of the subscriber's modem and bind it to a particular instance of both a dynamic IP address and an authenticated subscriber identifier, billing feature for billing a subscriber for network access provider charges and for payment requests from a content provider, receive the payment request, interpret a content tag of the content file transmission, send a request to a network access provider, identify a subscriber (the services in KOL bill to the account associated with the computer that is requesting the services – inherently using either or both of a dynamic IP

address and a subscriber identifier, as all services use for identifying individual users (see especially page 111, where a user by the name of “Mike Dee” has the “Screen Name” “Beatnik903”). When a user requests a “premium service” the request is tied to the IP address of the client (as this is inherently how networks communicate) and the username (as this is inherently how the user will eventually be charged for premium services);

f. a database to authenticate content requestor information (the online services must inherently store a database of the users who are authorized to connect and use the services) and to determine network access provider information (the services in KOL bill to a username and account),

g. a payment server, wherein the server is one selected from a server associated with the content transmission and a payment server aggregation point (the payment server is inherently at least associated with and/or administered by the online service, as the services in KOL bill directly to a user’s account),

h. wherein the service logic is configured to enforce license requirements and business rule requirements including payment requirements for playback of the media content (the software used by the services in KOL was distributed by the services themselves, who were able to set any preferences as to business rules and license requirements);

i. wherein the billing feature is configured to provide billing information to the network access provider in at least one of the formats from a group consisting of real time and periodic billing information (KOL, pages 27-29, cover monthly billing systems,



inherent in the art of network access systems – including the billing of premium services);

j. billing feature configured to present the offer to bill the network access provider to the subscriber as the only payment option (the premium services offered by the information services in KOL were generally the sole operators of many of these services, and billed directly to the user's account);

k. service logic configured to receive an indication of transport parameters associated with the content file transmission, and to transmit the transmission in accordance with the transport parameters, wherein the parameters include at least one from an exclusion of usage fees (page 17, “a flat monthly fee of \$9.95 gets you unlimited access”), an inclusion of usage fees (page 19, “a monthly fee of \$9.95, which gives you five hours of use”), a byte cap restriction (well-known to those skilled in the art at the time of the invention), the removal of a byte cap restriction (well-known to those skilled in the art at the time of the invention), a decreased bandwidth (page 23, “it runs pretty well at 2400 baud, so slow down and save”), and an increased bandwidth (page 23, “Genie also charges extra for...9600 bps access”).

14. Claims 8-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Films in view of KOL, further in view of “Times Online to charge by phone bill”, a story from The Guardian, published 19 March 2002 (hereafter “Times”).

15. As per claims 8-11, Films in view of KOL and Times teaches:

- l. wherein the content provider is an online merchant (Films teaches an online merchant, see ¶1 of Netco – “roll out a for-pay system...distribute...films”);
- m. preferred transported is capable of arbitrating between multiple online merchants (the services in KOL, such as the different services mentioned on page 17: “CompuServe features ‘premium services’ such as research databases...”), multiple payment gateways, and multiple network access providers (neither Films, KOL, nor the combination of the two, explicitly disclose a system where multiple payment gateways or multiple network access providers may be used to bill users for access to services. Times discloses a service whereby users may bill content access to a “monthly mobile phone bill” – ¶4 notes that “the vast majority of users turn away from websites as soon as they are asked for their credit card details”. By allowing users to bill content acquisition to their cell phones (no matter which network the cell phone were on), it creates a more easy to use system where users will be less likely to “turn away” from the website, instead inputting their mobile number and being billed appropriately for the content they wish to access. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow users to bill content to their cell phones, as it creates a more successful system that users are more likely to employ. A person having ordinary skill in the art would understand this as being advantageous as it generates more revenue for the hosting website);
- n. billing feature is configured to bill for microtransactions (the services in KOL all may have different prices, note page 17: “...such as forums is \$4.80/hour...some areas can end up costing more than \$20 an hour...”);

- o. pre-establishing accounts for online merchants with a network access provider (Times, ¶6 - “All users have to do is input their mobile number to unlock restricted parts of the site...”);
- p. preferred transporter is configured to provide preferred transporter service to pre-established accounts (Times, ¶6 - “They will then be simply charged for usage on their monthly telephone bill”; ¶9 - “A user simply has to input their telephone number once and they will be sent a text message with a special pin number”; ¶11 on page 3 - “The payment system could also be used if people wanted to see the most up-to-date information, such as the latest cricket scores, or they could chose to wait until it became free...”).

### *Response to Arguments*

16. As for the arguments concerning a “distributed peer-to-peer network”, the Examiner first contends that the network described in the arguments (pages 8 and 9) was not disclosed in the original application submission; the Examiner was only able to find references to typical peer-to-peer networks (see especially pages 17, 26 of the specification).

- q. Additionally, peer-to-peer networks are inherently “distributed” in that the clients are not all located in close proximity to one another, so this word adds no additional patentable weight. A person having ordinary skill in the art would not understand how a “distributed” peer-to-peer network is different from a normal peer-to-peer network.
- r. Furthermore, Applicant claims that Napster, the prior art mentioned in the previous action (but no longer directly applied in this action), is an example of a network

included a “central authority for subscribers and content and a peer-to-peer file downloading system” (emphasis added). The Examiner asserts that this is incorrect – see, for example, A&M RECORDS, Inc. v. NAPSTER, INC., 239 F.3d 1004 (9th Cir. 2001). The decision mentions that a registered user who wishes to share music would activate the software, at which point “the names of the MP3 files will be uploaded from the user’s computer to the Napster servers. The content of the MP3 files remains stored in the user’s computer” (section B, “Listing Available Files”, ¶7). Note that only the names of the files (rather than the files themselves) are uploaded to Napster’s multiple servers (rather than a single central server).

17. Lastly, Applicant's arguments with respect to claims 2-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- s. United States Patent 6,339,785 B1 (Feigenbaum)
- t. “Internet anywhere”, story from CNN.com, from 7 September 1999. Covers the ability to browse the Internet from devices such as the “cell phone in your purse”. Combined with the Times reference above, it creates a system that allows users to bill their network content purchases and usages to the same device they are using to browse said network.

19. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher C Johns  
Examiner  
Art Unit 3621

CCJ

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621